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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,713	08/06/2001	Takayuki Usui	Q65607	8286

7590 12/22/2003

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/22/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,713

Applicant(s)

USUI ET AL.

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 11, 27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 11, 27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/302,259.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 21, 2003 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo (4,992,815). Kudo `815 discloses a printing plate packaging box comprising: a box main body (13) which accommodates a bundle of photosensitive printing plates (11) and which is provided with a supply opening through which the photosensitive printing plates are taken out; an opening/closing lid (12) which is removably attached to said box for opening/closing the supply opening; and a light shielding member (groove portion (13b) and circumferential peripheral edge of lid (14), see Figure 1 embodiment and column 2, lines 34-38) which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main

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body and the opening/closing lid are connected to each other in an assembled state, the light-shielding member (circumferential peripheral edge) being connected to the opening/closing lid such that the light-shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are connected to each other in the assembled state.

It would have been obvious to one of ordinary skill in the art at the time the invention was made not to wrap the bundle of photosensitive printing plates in a light shielding wrap, since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. The printing plate packaging box of Kudo '815 prevents direct entry of light from outside into the inside of the box irrespective of the light shielding wrap.

4. Claims 8, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dirx (5,893,002). Dirx '002 discloses a printing plate packaging box comprising: a box main body (20) which accommodates a bundle of photosensitive printing plates (27) and which is provided with a supply opening through which the photosensitive printing plates are taken out; an opening/closing lid (42) which is removably attached to said box for opening/closing the supply opening; and a light shielding member (frame 41, see column 4, lines 38-40) which prevents direct entry of light from outside into the inside of the box main body, provided in the vicinity of a zone in which the box main body and the opening/closing lid are connected to each other in an assembled state, the light-shielding member being connected to the opening/closing lid such that the light-

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shielding member blocks the direct entry of light from outside into the inside of the box through the zone in which the box main body and the opening/closing lid are connected to each other in the assembled state. See Figures (5 and 10 embodiments).

It would have been obvious to one of ordinary skill in the art at the time the invention was made not to wrap the bundle of photosensitive printing plates in a light shielding wrap, since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. The printing plate packaging box of Dirx '002 prevents direct entry of light from outside into the inside of the box irrespective of the light shielding wrap.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over either of Kudo '815 or Dirx '002 in view of Lermer (5,495,944). Each of Kudo '815 or Dirx '002 as described above disclose all the limitations of the claim except for a smooth sheet-type material adhered to the outer surface of the packaging. Lermer '944 discloses that it is old and conventional to adhere a sheet-type material of which surface is smooth and airtight to the outer surface of a packaging in order to make it air tight (see column 1, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adhere a sheet-type material of which surface is smooth to the outer surface of the packaging of Kudo '815 or Dirx '002 as taught by Lermer '944 in order to make the packaging air tight and prevent the contents from damage.

Response to Arguments

6. Applicant's arguments filed October 10, 2003 have been fully considered but they are not persuasive. Omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Conclusion

7. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
December 18, 2003